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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 018842.1272

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/647,218	August 26, 2003

First Named Inventor: Anri ENOMOTO

Art Unit	Examiner
3746	Ryan P. GILLAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 59,903
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Sam C. Olive
Typed or printed name

(202)-639-1324
Telephone number

April 23, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)		
	)		
Anri ENOMOTO	)	Examiner:	Ryan P. GILLAN
	)		
Application No.: 10/647,218	)	Group Art Unit:	3746
	)		
Filed: August 26, 2003	)	**Confirmation No.:**	**1899**
	)		
For: CLUTCHLESS VARIABLE DISPLACEMENT REFRIGERANT COMPRESSOR WITH MECHANISM FOR REDUCING DISPLACEMENT WORK AT INCREASED DRIVEN SPEED DURING NON-OPERATION OF REFRIGERATING SYSTEM INCLUDING THE COMPRESSOR	)		

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicant is submitting the following remarks with a Pre-Appeal Brief Request for Review in accordance with the Official Gazette Notice of July 12, 2005, and the Extension of Pre-Appeal Brief Conference Program, dated January 10, 2006. Applicant is filing this Request concurrently with a Notice of Appeal and a Request for a Two-Month Extension of Time to respond to the final Office Action in the above-captioned patent application. Applicant respectfully requests that the Panel of Examiners (the "Panel") reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Rejections

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a), as allegedly being rendered obvious by U.S. Patent No. 5,624,240 to Kawaguchi et al. ("Kawaguchi") in view of U.S. Patent No. 5,513,553 to Gleasman et al. ("Gleasman"). Applicant respectfully disagrees.

2. 35 U.S.C. § 103(a)

a. The Office Action Impermissibly Relies on Non-Analogous Art

As a threshold criteria, the references used to establish the prima facie case of obviousness must be analogous art to the challenged invention. MPEP § 2141.01(a). In order for a reference to be analogous art, the reference must satisfy one of two criteria. First, the reference may be "in the field of the applicant's endeavor." Id. Alternatively, the reference may be "reasonably pertinent to the particular problem with which the inventor was concerned." Id. Specifically, "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is [a reference] which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Id. Applicant respectfully submits that Gleasman is non-analogous art with respect to the claimed invention, and as such, may not properly be combined with Kawaguchi.

Gleasman relates to high-speed, high pressure hydraulic machinery, while Applicant's invention is related to refrigerant compressors. Moreover, Gleasman explicitly states that persons of skill in the art consider the field of hydraulic machinery non-analogous to the field of refrigerant compressors:

> We use the term "non-analogous" art because automotive and industrial hydraulic machines run at high speeds e.g., 2000 rpm) and high pressure (e.g., 6,000 psi), and persons skilled in the design of such machines do not consider low speed/low pressure refrigerant gas compressors to be part of the same art.

Gleasman, Column 2, Lines 46-52 (emphasis added). Gleasman's machines and the compressors described in the above-referenced application operate in different environments, with different speeds, and with different pressure conditions. The Office Action argues that Gleasman and Kawaguchi are analogous art because the machine disclosed in Gleasman and the machine disclosed in Kawaguchi have parts that "are interchangeable between hydraulic and

refrigerant compressors," and because the parts of Kawaguchi relied upon by the Office Action are "not affected by the speed of the compressor." See Office Action, page 5, lines 11-14.

Even assuming arguendo that the Office Action's assertions were true, the Office Action would continue to fail to meet its burden in establishing a prima facie case of obviousness. MPEP 2141.01(a) requires that in order for a reference to be analogous art, the reference must satisfy one of two criteria. First, the reference may be "in the field of the applicant's endeavor." Id. Alternatively, the reference may be "reasonably pertinent to the particular problem with which the inventor was concerned." Id. Specifically, "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is [a reference] which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Id. Merely arguing that the non-analogous art has parts that are interchangeable with the analogous art, even if true, does not satisfy the requirements set forth by the MPEP. The Office Action has put forth no pertinent evidence to support its claim that Gleasman and Kawaguchi are analogous art, nor has the Office Action refuted the ***explicit*** statement in Gleasman that those of skill in the art do not consider low speed/low pressure refrigerant gas compressors, similar to that which is recited in the above-captioned application, to be part of the same art.

b. The Combination of Kawaguchi and Gleasman Does Not Disclose or Suggest All of the Limitations of Independent Claim 1.

Applicant's independent claim 1 recites "determining means for determining the inclination angle of the swash plate to an initial angle . . . and releasing means for releasing the inclination angle determining means when compression work of the compressor is increased after said drive shaft is driven by the external driving source." Applicant respectfully submits that neither Kawaguchi nor Gleasman discloses or suggests the determining means and releasing means limitations set forth in independent claim 1.

The Office Action admits that Kawaguchi fails to teach or suggest the determining means and the releasing means limitations of claim 1, and cites Gleasman as allegedly curing these deficiencies. The Office Action alleges that "Gleasman discloses a releasing means 180, which is used to adjust the swash-plate. The release means **can** adjust the determining means 172 and therefore **can** adjust it to a released position, therefore servo-mechanism 180 **can be utilized** as a releasing means." See Final Office Action, Page 5, Lines

14-19. Applicant notes that even assuming arguendo that the Office Action's assertion were true, a prima facie case of obviousness has not been established. Merely stating that a reference **could** be modified to arrive at the claimed invention is not sufficient; the Office Action must show that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references to arrive at the claimed invention. See Ex parte Leavengood, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Interf. 1993). Applicant additionally disagrees with the Office Action's assertions. The Office Action concludes that because servo-mechanism 180 is configured to adjust toggle-link 172 (determining means), servo-mechanism 180 necessarily must be configured to release determining means 172. However, Gleasman merely discloses that servo-mechanism 180 may move determining means 172 to the right and to the left. See Gleasman, Col. 17, lines 24-57. Servo-mechanism 180, as shown in Fig. 15 of Gleasman, includes servo-piston 182 and control rod 186 moving in a bounded, back-and-forth motion to the right and left. If the determining means 172 of Gleasman could be inclined to a separate minimum angle corresponding to a "released position," control rod 186 must be pushed or pulled to a position corresponding to that angle. The servo-mechanism 180 illustrated in Fig. 15 may move cyclically the determining means 172, but the motion of control rod 186 is limited to a back-and-forth motion in a controlled space. Servo-mechanism 180 does not move determining means 172 beyond its normal operating range of motion, nor does the servo-mechanism 180 release the determining means 172.

Further, claim 1 recites that the inclination angle determining means is released when "compression work of the compressor is increased and after the drive shaft is driven by the external driving source." Even assuming arguendo Gleasman fails to teach or disclose that any specific motion of servo-mechanism 180 is initiated when the compressor increases the compression work after the drive shaft is driven by the external driving source.

c. The Office Action Fails to Establish Sufficient Suggestion or Motivation to Combine Kawaguchi and Gleasman

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so . . . ." MPEP § 2143.01. Applicant respectfully submits that the Office Action fails to demonstrate a motivation or suggestion to modify Kawaguchi to include the toggle-link and control piston of Gleasman for "determining the inclination angle of the swash

plate to an initial angle when said drive shaft is stopped without being driven by the external driving source." For example, Gleasman states that because of its "inventive structures, our hydraulic machine provides relatively high horsepower in a remarkably small format; i.e., it remarkably exceeds the horsepower densities of present commercially-available units of similar physical dimensions." Gleasman, Column 5, Lines 18-22. The Office Action has shown no motivation or suggestion to modify Kawaguchi to include the toggle-link and control piston from the small, high power, hydraulic machine of Gleasman to determine the inclination angle of the swash plate in a clutchless refrigerant compressor. Therefore, Applicant respectfully requests that the Panel withdraw the obviousness rejections of claim 1.

Conclusion:

Applicant respectfully submits that the above-captioned patent application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representative, we would welcome the opportunity to do so. Applicant respectfully requests that the U.S. Patent and Trademark Office charge the requisite $500 large entity fee for a Notice of Appeal to undersigned's Deposit Account No. 02-0375, and in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit such variance to the undersigned's Deposit Account.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: April 23, 2007

By: _____

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